

REMARKS

Claims 54-84 were pending in the application. Claims 54-56, 59-65, 67-68, 70, 72-73, 76-77, 79, 81 and 83-84 have been amended. Claims 85-132 have been added. Therefore, claims 54-132 are now pending in this application.

Section 101 Rejections

Claim 1 was rejected under 35 U.S.C. Section 101 as not being “limited to tangible embodiments” (Office Action, page 3). Applicant notes that Claim 1 was cancelled in a previous amendment, and thus, is not pending in the application. Clarification is requested.

Claim 54 was also rejected under 35 U.S.C. Section 101. In particular, the Examiner states that “Claim 54 includes invention methods without support[] from tangible embodiments (e.g., CD-ROM drive, hard disk drive or diskettes). As such the claim is not limited to statutory subject matter and is therefore non-statutory.” Applicant notes that claim 54 is a “method” claim, which clearly falls under Section 101’s recitation of a “process.” Applicant notes that Claim 54 recites “sending”, “providing,” “conveying,” and “receiving,” all “via a public network.” Still further, claim 54 recites “displaying a graphical interface.” These recited operations are manifestly physical operations, not abstract ideas. As such, Applicant has satisfied any prohibition against recitation of an abstract concept that may be present in Section 101. With regard to the Examiner’s rejection, Applicant is aware of no requirement that computer-based method steps explicitly recite hardware such as that listed by the Examiner. The Examiner is kindly requested to provide authority for this statement.

Section 112 Rejections

Claim 54 was rejected under 35 U.S.C. Section 112, first paragraph, as failing to meet the written description requirement and the enablement requirement relative to the recited terms “first personal information” and “second personal information” and the phrase “second personal information relating to said first user”. Applicant respectfully disagrees with this rejection, noting that the terms “first” and “second” in the cited context were merely used as labels to facilitate later reference to the “personal information” subsequently in the claim. However, in

order to expedite the case towards an allowance, Applicant has amended claim 54 in a manner that is believed to overcome the Examiner's rejections.

Claims 54 and 55 were rejected under 35 U.S.C. Section 112, first paragraph, as failing to meet the enablement requirement relative to the recited term "information sharing service." Applicant respectfully disagrees with this rejection. Nonetheless, Applicant has replaced this term in the claims with "information distribution service." Applicant submits that this phrase is supported at least by paragraph [0004] of the published application. Applicant further notes that one (non-limiting) example of an "information distribution service" is the Real-Time Social Network (RTSN) described extensively in the application. The rejected claims are, of course, not limited to the disclosed RTSN. Applicant further notes that the Examiner's proposed definition of "information sharing service" appears to focus on client-side applications. While such platforms may be used to access an "information distribution service," the client-side interface is not the "service" itself. By the term "service," Applicant refers to the functionality of distributing of information between, for example, users of the system. The disclosed RTSN is one (non-limiting) example of a system that provides such a "service," allowing various users to have accounts and facilitating the distribution of information (e.g., from business entities to users, users to users, etc.). Thus, "service" may refer to the functionality supplied to one or more users of client computer systems or devices, etc. by one or more server computers. The Examiner is requested to contact the undersigned by telephone if further clarification is requested.

Claim 56 was rejected under 35 U.S.C. Section 112, first paragraph, as failing to meet the written description requirement and the enablement requirement relative to the recited term "memory subsystem". Applicant respectfully disagrees with this rejection. This term is *clearly* supported in the specification by the numerous references to computer systems. Among other places, see Fig. 11 (esp. elements 1106, 1108, 1110, 1112, and 1114) and paragraph [0051] of the published application. Given this support, Applicant submits that the enablement rejection is also in error.

Claim 54 was rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite. In particular, the Examiner did not "understand the business relationships between

‘business entities’ and ‘first personal information/ and second personal information’”. Applicant notes that neither former Claim 54 nor presently amended Claim 54 recite “business relationships” between business entities and first personal information or second personal information. Thus, this rejection is not appropriate. Applicant notes, however, that claim 54 now recites “wherein said associating permits the plurality of business entities to provide content that is accessible to the first user via the first account of the information distribution service.” The specification of the published application is replete with non-limiting examples of this quoted language. *See, e.g.*, paragraph [0170]. The Examiner is requested to contact the undersigned if further clarification is requested.

Claim 54 was rejected under 35 U.S.C. Section 112, second paragraph, as lacking antecedent basis for the recitation of “said information” at line 3 of that claim. However, please note that line 2 of that claim recites “sending, via a public network, information” Thus, the recitation of “said information” in line 3 has sufficient antecedent basis.

Claims 54-55 were rejected under 35 U.S.C. Section 112, second paragraph, as lacking antecedent basis for the recitation of “via said service” in claim 54, lines 12 and 19 and in claim 55, line 7. Applicant submits that “service” refers to the term “information distribution service” mentioned previously in those claims.

Claim 56 was rejected under 35 U.S.C. Section 112, second paragraph, as lacking antecedent basis for the recitation of “said service”. Please note that the preamble of claim 56 recites “an information distribution service,” which clearly provides antecedent basis for the term “service.”

Art Rejections

Claim 54 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Guan (U.S. Publication No. 2001/0027472) in view of Rubin et al. (USPN 6,735,624). Applicant traverses this rejection.

The Proposed Combination of Guan and Rubin Does Not Yield Claim 54

Guan¹ discloses an “InfoID” system in which a doctor may supply “medical data” from the examination of a patient (“Jeff”) to a “central database,” which may lead to the medical data ending up as being available as part of Jeff’s medical record which is “kept under Jeff’s own unique information ID ... in the central database.” See Guan at [0092]-[0093]. Rubin, on the other hand, discloses a “portal” similar to those described and criticized in Applicant’s specification at paragraphs [0007] and [0008]. Rubin’s portal merely allows the retrieval of certain public information (e.g., current stock values, weather) based on information specified by the portal user. See Rubin at col. 2, lines 61-67.

The Examiner suggests that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Rubin’s ideas of including sharing stock portfolios into Guan’s system in order to be able to expand[] functions of Guan’s InfoID portal system to increase economic benefits for the users” (citing Rubin, col. 2, lines 52-67).

Applicant submits, however, that the proposed combination of Guan and Rubin would still lack certain features of claim 54. First, the proposed modified InfoID system of Guan would lack the “automatic[]” “recei[pt]” and “display” of “received content” upon an access request being validated as recited in claim 54. Guan does not disclose such features [Guan includes only the vague suggestion that certain information from one user is made available to another user via a database], and Rubin’s portal does not appear to retrieve “personal, non-public content that relates to the first user.” Second, neither reference refers to the notion of “associating” “business entities” and the “first user” via the service, “permit[ting] the plurality of business entities to provide content that is accessible to the first user via the first account of the information

¹ Applicant submits that the Examiner has not demonstrated that Guan is proper prior art to the present application, which claims priority to a provisional application 60/196,082 dated April 11, 2000.

distribution service,” and then the service selecting, for “automatic[]” “recei[pt]” and “display” by the first user, “personal, non-public content that relates to the first user and is not provided by the business entities to other users of the service,” wherein the service selects this content based on a “time value” of the content “satisfying one or more time-based criteria specified by the service,” as is recited in claim 54. Furthermore, Guan does not teach the concept of selecting provided content for display by the first user, much less selecting based on a “time value” as in claim 54. Rubin’s portal does not receive “personal, non-public content that relates to the first user and is not provided by the business entities to other users of the service,” much less select such content for automatic[]” “recei[pt]” and “display” by the first user based on the “time value” of claim 54.

Because the cited art does not teach or suggest the above-noted features, Applicant submits that the cited references do not support a *prima facie* of obviousness. See *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 938 (Fed. Cir. 1983) (“None of the references teaches the compound slope feature of the invention.”). Thus, even assuming *arguendo* that the motivation to combine Guan and Rubin suggested by the Examiner is proper (which Applicant does not concede), the proposed combination does not include all of the features of amended claim 54. Applicant therefore contends that claim 54 is patentably distinct over the cited references.

The Proposed Combination of Duhon and Guan Does Not Yield Claims 55, 56, 73, or 84

Claim 55, 56, 73, and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Duhon (U.S. Publication No. 2001/0011245) in view of Guan. Applicant traverses these rejections.

The “principal customers” of “credit information services” such as Duhon’s are described at paragraph [0005] of that reference, and do not include consumers. Rather, Duhon’s users are largely “credit grantors” and no mention appears to be made of consumers being users of such a system. See Fig. 16 and paragraph [0086]. Accordingly, Duhon’s system does not “receive content” that “includes personal, non-public information relating to the first user,” select “first and second pieces of content” from the received content, and then “in response to said first user logging on to said service, *automatically provide a graphical user interface to said first user*, wherein said graphical user interface concurrently displays at least an indication of said first and second pieces of content,” as recited in claim 55. Instead, the information sharing paradigm in

Duhon relates to entities providing credit-related information on consumers, which is then stored, processed, and shared with entities interested in the credit worthiness of one or more consumers. Thus, while Duhon may distribute information relating to a particular consumer, the consumer is not described as a user of the Duhon system. Thus, Duhon does not describe “provid[ing]” “personal, non-public information relating to [a] first user” *to* “the first user” as in claim 55. Duhon is therefore quite different from the system of claim 55.²

Applicant respectfully requests that the Examiner explain the functioning of the proposed combination of Duhon and Guan. Duhon is a system for entities to determine credit worthiness of consumers. Guan is alleged to be a system for users of the system to share personal information. Assuming *arguendo* that the teachings of Guan would even be considered relevant to Duhon (and Applicant does not concede, as the Examiner suggests, that the references are necessarily in analogous arts), the teachings of Guan must be applied to Duhon in a way that makes sense in the context of the latter reference. It is unclear what a Duhon-as-modified-by-Guan system might look like, but Applicant suggests that, at best, such a system would merely permit users of the Duhon system to share information with one another. Such a system would lack, however, the above-noted features of claim 55. Further, this proposed combination would also lack other features of claim 55 (e.g., the associated time value and the use of this value to select content based on “time-based criteria”).

For at least these reasons, Applicant submits that claim 55 is patentably distinct over the cited references. Independent claims 56, 73, and 84 are also believed patentably distinct over the cited references for at least reasons similar to those provided above for claim 55. Dependent claims of these claims are also believed to be patentably distinct over the cited art for at least the reasons provided for their respective independent claims.

The Examiner Has Not Provided an Adequate Motivation to Combine Duhon and Guan

The Examiner provides the following rationale for combining Duhon and Guan:
See Office Action at 10.

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Guan’s ideas of sharing personal information to other

² Furthermore, for the reasons outlined above, Applicant disagrees with the Examiner’s contentions stated in

users according to sharing control information with Duhon's system in order to improve conveniences and economic benefits for the portal system users, see (Guan: [0009]-[0011]).

Applicant submits that in addition to the fact that a Duhon-Guan combination does not teach all the limitations of claim 55, the Examiner's stated motivation for combining these references is inadequate. What "economic benefits" or "conveniences" would accrue to users of Duhon's credit-checking system by applying the teachings of Guan? Again, recall that the user of Duhon's systems are entities checking the credit worthiness of consumers. Because Guan is alleged to teach information sharing among users of a system, why would Duhon's users (e.g., credit card companies) wish to share "personal" information about themselves with each other? (It is unclear whether the term "personal" information as it relates to a credit card company has any meaning.) Applicant submits that the Examiner's proposed modification of Duhon simply makes no sense, and that one of ordinary skill in the art would not be motivated to apply the teachings of Guan to Duhon. For this further reason, Applicant submits that independent claims 55, 56, 73, and 84 and their respective sets of dependent claims are patentably distinct over the cited references.

Newly Added Claims

Newly added claim 85 is believed to be patentably distinct over the cited references, as those references are not believed to teach, among other things, "wherein each of the first plurality of messages has an associated time value indicative of a time-based priority of the message, and wherein each of the first plurality of messages was selected for delivery to the first user based on its associated time value satisfying one or more time-based criteria specified by the information distribution service." Claim 85 and its dependents are therefore believed to be in condition for allowance.

Newly added claim 104 is believed to be patentably distinct over the cited references, as those references are not believed to teach, among other things, "the computer system automatically selecting, from the received content, content whose associated time value satisfies one or more time-based criteria specified by the service." Claim 104 and its dependents are therefore believed to be in condition for allowance.

Numerous dependent claims are believed to be patentably distinct over the cited references. However, given the fact that all independent claims are believed to be in condition for allowance, it is not believed necessary to address the dependent claims at this time.

CONCLUSION:

Applicants submit the application is in condition for allowance, and an early notice to that effect is requested.

Applicant has petitioned herewith for what is believed to be the appropriate extension of time. If any further extensions are necessary to prevent the above-referenced application from becoming abandoned, Applicant hereby petitions for such extension.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 501505/5957-71800/DMM.

Respectfully submitted,

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